

Inventor: Bruce C. Johnson

Serial No.: 08/615,814

-6-

REMARKS

This communication is in response to Action of February 13, 1997 supplementing the Action of January 27, 1997. In this last Action, claims 1 through 22 have been rejected, and this rejection has been made final. This communication is also in response to a telephonic interview with the Examiner on March 12, 1997 and a communication from the Examiner dated March 17, 1997, including a summary of the telephonic interview, and an Advisory Action dated March 3, 1997.

The applicant has amended claims 1 and 8 to clarify the invention claimed therein, and has rewritten claims 10, 12, 14 and 15 in independent form to overcome the rejection thereof for depending on rejected claims. The applicant has added claims 23 and 24 to more fully claim the present invention.

The Examiner in the communication dated March 17, 1997 indicates that the double patenting rejections have been overcome.

The applicant has amended the claims to recite nasal dilators rather than dilators, and therefore the applicant believes that the rejection of the specification and the claims under 35 U.S.C. §112 has been overcome.

The Examiner has rejected claims 8, 9, 11, 13, 17, 20 and 22 under 35 U.S.C. §103 as being obvious in face of U.S. Patent No. 1,292,083 to Sawyer. The Examiner appears to contend that wire 7 alone in the Sawyer reference can serve as a truss of a single body with the result that loops 6 and pads 5 of the Sawyer device together must serve as part of the engagement means to meet claim 8 in view of their only being a truss and an engagement mean recited therein. The Examiner apparently finds that the mechanical attachment of loop 6 and pads 5 to wire 7 is the equivalent of adhering the engagement means to the single body truss as recited in claim 8. Here the applicant must respectfully disagree as there cannot be any such equivalency in view of the requirement of the Sawyer device to have spring 7 therein mechanically detach from loop 6 to allow adjustment of the spring force provided by wire 7. Such a detachability which would not be possible in an attachment of loops 6 and pads 5 to wire 7 based on adherence if such adherence is to be maintained.

Inventor: Bruce C. Johnson

Serial No.: 08/615,814

-7-

Furthermore, the applicant must respectively disagree with the Examiner's position that the declaration of the Chief Executive Officer of the licensee of the applicant's assignee, submitted with the last amendment before this Action, exhibits a lack of nexus between the subject matter claimed in claim 8 and the subject matter described in that declaration as being the basis for providing the commercial success. Claim 8 requires a dilator with a truss exhibiting a restoring force capable of engaging the outer wall tissues of a user's nose against such a force without any details being recited in that claim of the structure providing such a force. Such a restoring force is exactly what the product described in that declaration provides, and there is not the slightest evidence or indication that consumers give any consideration to the details of the structure providing this restoring force or that such details are part of their decision to purchase the product. Clearly, there is a very strong connection between the restoring force recited in claim 8 and the outward force on the wall tissue of a user's nose having the product of the licensee of the applicant's assignee positioned on the user's nose. In addition, the copying also described in this declaration by competitors of the product described therein in the designing and manufacturing of the competing products they have marketed, has resulted in those products from the competitors also being clearly within the scope of claim 8. Whether or not these competitors are making use of the invention set out in the limitations of claim 8 is the issue, and it is relevant that their products contain some additional construction details as they always will except in situations of identical copies.

However, the applicant has amended claim 8 to clarify the invention recited therein. The nasal dilator is directly set out as a single body device, and the restoring forces generated therein are recited to be due to plastic material in the truss. In the Sawyer reference, wire 7 is of a metal material which has a relatively short angular range of elastic behavior before plastic deformation of the metal occurs. Such a short angular range of elastic behavior is insufficient to provide adequate adjustment of spring forces in a dilator assembled on a user's nose, and so the ability to disconnect wire 7 from loop 6 is required so that the user is able to plastically deform wire 7 to a new neutral state, which the user hopes will provide a new angular range of elasticity satisfactory for adjusting the spring force on his or her nose. If not, the user

Inventor: Bruce C. Johnson

Serial No.: 08/615,814

-8-

must disconnect wire 7 again and further plastically deform that wire to yet another neutral state again hopefully having a resulting range of elasticity thereabout that is satisfactory to provide a suitable force on the user's nose.

The limitation of a single body device in claim 8 will by itself, of course, exclude from the scope of the claim any sort of an adjustable wire that fits closely to the user's nose, as in Sawyer, because of the need to detach the wire for any such adjustment. The reason the present invention can avoid such adjustment is that the plastic resilient members used in the present invention have a much larger range of elastic behavior before significant viscoelastic deformation occurs. The plastic material chosen for the present invention has an angular range of substantially elastic behavior large enough to allow forcing the truss end surfaces together and yet have the surfaces returned to the planar, or nearly planar, state from which it started without significant viscoelastic deformation in the plastic resilient members. This gives the user the ability to put the nasal dilator of the present invention on the user's nose directly without any need for adjustment. Thus, in addition to the limitation of a single body, there has been added to claim 8 the limitation of use of a plastic material in the providing of restoring forces. Together, these limitations clearly distinguish over the Sawyer reference. Added claim 24 has these limitations also set out therein.

The Examiner next indicated claims 10, 12, 14 through 16, 18, 19 and 21 would be allowable if rewritten to overcome the rejection under 35 U.S.C. §112 and to include the limitations in the claims upon which they depend, but to also have a scope differing from that of claims issued on previous applications. The applicant has rewritten claims 10, 12, 14 and 15 to place them in such independent form, bearing in mind the need to include the limitations of the claims upon which they depend but to also provide a scope differing from that of issued claims. Thus, some changes have been made to these claims in a way of omissions of recitations of resilient members and the like to provide a significantly different scope.

Finally, claims 23 and 24 have been added to more fully claim the present invention. Claim 23 is drawn as claim 18 of U.S. Patent 5,533,499 issued on the application parent to the present invention except for omitting the limitation of the truss being a single body.

Inventor: Bruce C. Johnson

Serial No.: 08/615,814

-9-

The patentability of this claim follows since claim 18 in the '499 patent apparently was allowable without regard to the truss recited therein being of a single body. Claim 24 has been added with the limitations indicated above.

In view of the foregoing comments, the applicant respectfully requests the Examiner to reconsider the rejection of the claims in view of the amendments, and further requests the Examiner to now allow these claims as amended.

Any inquiries regarding this application should be directed to Theodore F. Neils at (612) 339-1863.

Respectfully submitted,

KINNEY & LANGE, P.A.

By: 

Theodore F. Neils, Reg. No. 26,316

Suite 1500

625 Fourth Avenue South

Minneapolis, MN 55415-1659

Phone: (612) 339-1863 Fax: (612) 339-6580

TFN:alg

March 26, 1997